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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/817,374	03/26/2001	Daniel Delorme	106101.139	9679

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EXAMINER

BALASUBRAMANIAN, VENKATARAMAN

ART UNIT	PAPER NUMBER
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1624

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/817,374

Applicant(s)

DELORME ET AL.

Examiner

Venkataraman Balasubramanian

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-56 is/are pending in the application.
- 4a) Of the above claim(s) 5,22,34,40,41,45,46 and 50-56 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4,6-21,23-33,35-39,42-44 and 47-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

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DETAILED ACTION

Applicant's election with traverse of Group I, claims 1-4,6-21,23-33,35-39,42-44,47-49 and 52-56 in Paper No. 9 is acknowledged. In addition, as agreed, examiner will also examine Group II along with Group I. Both these groups will be examined to the extent they embrace the elected subject matter. Claims 5, 22, 34, 40-41, 45-46 and 50-56 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected subject matter. Applicants have asked to cancel non-elected claims 5, 22, 34, 40-41, 45-46 and 52-56 but there is no explicit separate statement to do so. Hence these claims remain in the application.

Claims 1-4,6-21,23-33,35-39,42-44,47-49 are active in the case.

The traversal is on the ground(s) that the instant invention does not lack a common core and that it would be undue burden to search all classes embraced by the instant invention.

This is not found persuasive because of reasons of record. As for the traversal the following apply.

Applicants' argument that instant Cy, which includes cycloalkyl, aryl and heterocyclic core, does not lack common core is misplaced. As noted in the previous office action, they are independent and distinct from each other because they are directed to dissimilar compounds with varying core. Consequently, the groups have different classifications and require separate prior art searches. Art, which may render obvious or anticipate one of the groups would not necessarily do the same for the other

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group as evidenced by the prior art cited in Information disclosure Statement which is a 102 reference for non-elected group.

Furthermore, applicants' contention that there is no serious search burden to examine all said groups is not entirely incorrect. First of all, applicants' invention as recited includes several cores and this generic definition includes therefore a large number of hetero and carbocyclic compounds. Thus the classification of these generic ring systems with above said substituents would be all over the classes and subclasses and it mandatory for the examiner to search all classes and subclasses. The fact all these can be grouped under 514, or 548 or 549 does not meant that the search burden is less. Applicants should note that under each of the above classes there are thousands of patents and to facilitate search they are further divided into subclasses. Even then some of the subclasses may have large number of patents. Hence, contrary to applicants' urging it would not be possible with the limited fixed time available for the examiner to examine each case to thorough search. Searching all possible classes and subclasses embraced by the generic definition of Cy would of serious search burden.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4,6-21,23-33,35-39,42-44,47-49 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Following reasons apply. Any claim not specifically rejected is rejected as being dependent on a rejected claim.

1. Claim 1 is indefinite as it is not clear what is the definition of R^3 . Claim 1 recites R^3 as "sulfonyl" which renders the claim indefinite as a "sulfonyl group is divalent group and it is not clear what other group is attached to it to meet the valence requirement.
2. The same rejection applies to claim 42 and claim 48, both of which recite "sulfonyl" group.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 8 and 42 are rejected under 35 U.S.C. 102(b) as being anticipated by Cohen et al. Tetrahedron Letters, 22(35): 3377-3380, 1981.(CAPLUS Abstract provided)

See compound of RN 808404-79-1 shown on page 2 of the CAPLUS abstract.

References cited in the Information Disclosure Statement (paper #7) are considered except for the International Search Report, which is not a publication per se and thus not properly cited as such in the Information Disclosure Statement. See MPEP

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2205. Applicants should also note that paper # 7 is cited as Supplemental Information Disclosure Statement, but examiner could not find any other prior Information Disclosure Statement in the case. A clarification is requested.

Conclusion

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (703) 305-1674. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is Mukund Shah whose telephone number is (703) 308-4716.

The fax phone number for the organization where this application or proceeding is assigned (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

V Balasubramanian
Venkataraman Balasubramanian

3/8/2003